

REMARKS

This Response is submitted in reply to the Office Action dated September 14, 2006. Claims 1, 18, 19, 32, 44, 57, 58, 65 and 72 are amended. Claim 2 stands canceled. No new matter was added by these amendments.

A Petition for a Two-Month Extension of Time to respond to the Office Action and a Supplemental Information Disclosure Statements are submitted herewith. The Commissioner is authorized to charge Deposit Account No. 02-1818 for any fees which are due in connection with this Extension of Time, this Supplemental IDS and this Response.

The Office Action rejected Claims 1 to 46, 49 to 51 and 54 to 74 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,823,874 to Adams ("Adams") in view of U.S. Patent No. 1,978,395 to Groetchen ("Groetchen") and Official Notice.

As discussed during the interview, Applicants respectfully disagree with and traverse these rejections. Nonetheless, to expedite prosecution, Applicants have amended certain of the claims to clarify that the server is remote from the gaming device and also to clarify the different functions of the server and the processor.

Amended independent Claims 1, 18, 32, 44, 57, 58, and 65 are each generally directed to a gaming device/method of operating a gaming device which include, amongst other elements, a processor programmed to randomly determine any symbols displayed by the second display, wherein a designated instruction sent from a remote server to the processor is independent of any symbols displayed by the second display.

Amended independent Claim 72 is generally directed to a gaming device which includes, amongst other elements, an award adapted to be provided to the player, the award obtainable in the secondary game and displayable by the secondary game display, wherein the processor is programmed to randomly determine the award displayed by the secondary display and a first actuator operable to move the first movable member to unmask the secondary game display after a designated instruction to reveal the secondary display is sent from the server to the processor, wherein the designated instruction sent from the server to the processor is independent of the award displayed by the secondary display.

The Office Action states that Adams discloses a gaming device incorporating primary and secondary game displays within a single housing. The Office Action also states that Groetchen discloses a slot machine device in which slidable members (i.e. shutters) selectively mask a display wherein the device selects symbol from the plurality of symbols, displays symbols on the display and reveals the symbols by moving the movable member.

The Office Action further takes Official Notice that regardless of the deficiencies in combining Adams and Groetchen (i.e., "the combination of Adams and Groetchen appears to lack that a processor is in communication with a server through a data network and that the server is capable of providing the gaming device instructions to operate at least the movable members"), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the gaming device specified by the combination of Adams and Groetchen on a gaming network, such that the processor is in communication with a host server and the host server provides instructions to the gaming device.

Applicants respectfully disagree that one of ordinary skill in the art would be motivated to modify the game of Adams based on Groetchen at the time of the present invention. Nevertheless, assuming for purpose of this response that one of ordinary skill in the art would be motivated to replace the secondary display of the gaming machine of Adams using Groetchen; Applicants submit that one of ordinary skill in the art would not be motivated to change the already modified Adams gaming device such that:

- (a) the processor operates in conjunction with a remote server to cause an actuator operable to move a movable member to reveal a secondary display after a designated instruction to reveal the secondary display is sent from the server to the processor of the gaming device (see Claim 1); and
- (b) said processor is programmed to randomly determine any symbols displayed by the secondary display, wherein said designated instruction sent from the server

to the processor is independent of any symbols displayed by the secondary display (see Claim 1).

The Office Action does not address why one of ordinary skill in the art would be specifically motivated at the time of the invention to have a remote server provided instructions for the control or operation of the actuator (and thus the movable member or door) while leaving the random determination of any symbols displayed by the secondary display under the control of the processor. Rather, the Office Action uses Official Notice to conclude that one of ordinary skill in the art would be motivated to add the modified Adams gaming machine to a network and a host server. Assuming for purpose of this response that one of ordinary skill in the art would be motivated to do so, the Office Action still does not explain why one of ordinary skill in the art would be motivated to divide the control between the server and the processor in the manner claimed.

The Office Action reasons that "the gaming device can essentially be a dummy computer that accepts any programmed game, thus reducing costs for replacing entire memory chips or devices with new games." However, again, assuming for purpose of this response that one of ordinary skill in the art would be motivated to configure the gaming device as a dummy computer that accepts any programmed game, the Office Action still does not explain why one of ordinary skill in the art would be motivated to divide the control between the server and the processor in the manner claimed.

The Office Action further reasons that "[a]dditional motivation lies in the popular progressive gaming area, such that a host server must keep track of all money added to the progressive jackpot by the gaming devices that are part of the jackpot, thus, connectivity to a server through a data network must be present, such that when a particular gaming device [sic] wins the progressive or the like, the host server can transmit the instructions to the gaming device to reveal a secondary display with the bonus information." However, Applicants respectfully submit that in such a configuration, the progressive amount which is displayed by the secondary display is kept track of or controlled by the server (i.e., the server maintains the amount of the progressive) and is not randomly determined by the processor. The server (and not the

processor) thus determines the progressive amount displayed by the secondary display. Accordingly, such progressive gaming systems appear to teach away from the processor randomly determining the symbols displayed by the secondary display.

Moreover, during the interview and in the interview summary, the Examiner appears to take the position that it would be obvious to control any signal remotely (such as the signal to cause the actuator to move the moveable member to reveal a secondary display). The problem with this reasoning, however, is that it does not explain why a person of ordinary skill in the art would be motivated to: (1) first start with the Adams gaming device, (2) then modify the Adams gaming device with Groetchen, (3) then add the Groetchen modified gaming device to a network system with a remote server, and (4) then have the server provide instructions to control the opening of the moveable member - but still have the processor of the gaming device randomly determine the symbols displayed by the secondary display behind the moveable member.

Applicants respectfully submit that the Examiner is using improper hindsight to reach this conclusion. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. An Office Action cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention.

In this case, the Office Action improperly used hindsight reasoning by combining previously uncombined features from one gaming device with primary and secondary game displays, from one gaming device with slidable members selectively masking a portion of the secondary display, and from an Official Notice of a gaming network with a host server to conclude that a gaming device having the elements of independent Claims 1, 18, 32, 44, 57, 58, 65 and 72 is obvious. The Office Action is improperly picking and choosing individual elements from these separate gaming devices/gaming network to form the gaming device of independent Claims 1, 18, 32, 44, 57, 58, 65 and 72. The Office Action is selectively picking specific elements from each of these separate references without having a specific motivation for picking that element from each reference. This is an improper basis for the obviousness rejection of independent Claims 1, 18, 32, 44, 57, 58, 65 and 72.

Specifically, the Office Action: (1) selected Adams for a primary and secondary game displays within a single housing; (2) selected Groetchen for slidable members which selectively mask a display wherein the device selects symbol from the plurality of symbols, displays symbols on the display and reveals the symbols by moving the movable member; and (3) selected the Official Notice for a processor in communication with a host server and the host server providing instructions to the gaming to recreate the elements of the gaming device of independent Claims 1, 18, 32, 44, 57, 58, 65 and 72. As described above, without a suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 1, 18, 32, 44, 57, 58, 65 and 72, the Office Action is improperly using hindsight reasoning as the basis for this obviousness rejection. In other words, when the invention is looked at as a whole, it would not be obvious to one of ordinary skill in the art at the time of the invention. Accordingly, for these reasons, Applicants respectfully submit that such rejection be withdrawn, that amended independent Claims 1, 18, 32, 44, 57, 65 and 72 are patentably distinguished over the prior art cited and that such claims are in condition for allowance.

Claims 2 to 17, 19 to 31, 33 to 43, 45, 46, 49 to 51, 54 to 56, 59 to 64, 66 to 71, 73 and 74 depend directly or indirectly from independent Claims 1, 18, 32, 44, 58, 65

and 72 and are also allowable for the reasons given with respect to Claim 1, 18, 32, 44, 58, 65 and 72, and because of the additional features recited in these claims.

The Office Action rejected Claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Groetchen and Official Notice in further view of U.S. Patent No. 6,086,066 to Takeuchi et al. ("Takeuchi").

The Office Action states that Takeuchi discloses a gaming system which describes sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is set in its desired position. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system suggested by the combination of Adams in view of Groetchen and Official Notice to add the feature of sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is revealed to provide feedback to the game processor and thereby improve control or detect malfunctions in the operation of the movable member.

Applicants respectfully submit that the addition of Takeuchi does not cure the deficiencies described above with the improper combination of Adams, Groetchen and Official Notice. That is, the addition of Takeuchi does not explain why a person of ordinary skill in the art would be motivated to: (1) first start with the Adams gaming device, (2) then modify the Adams gaming device with Groetchen, (3) then modify the Groetchen modified gaming device with Takeuchi, (4) then add the Takeuchi modified gaming device to a network system with a remote server, (5) then have the server provide instructions to control the opening of the moveable member - but still have the processor of the gaming device randomly determine the symbols displayed by the secondary display behind the moveable member. Accordingly, Applicants respectfully submit that such rejection be withdrawn, that Claims 47 and 48 are patentably distinguished over the prior art cited and that such claims are in condition for allowance.

The Office Action rejected Claims 52 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Groetchen and Official Notice in further view of U.S. Patent No. 4,326,351 to Heywood et al. ("Heywood").

The Office Action states that Heywood discloses a gaming device having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system suggested by the combination of Adams in view of Groetchen and Official Notice to add the feature of a secondary display device having a medium exhibiting symbols that is coupled between a driver roller and follower roller such that one of the symbols is shown in the second display to provide an alternative to a reel display while allowing players to see the symbols belong to an unalterable strip and avoiding an artificial appearance.

Applicants respectfully submit that the addition of Heywood does not cure the deficiencies described above with the improper combination of Adams, Groetchen and Official Notice. That is, the addition of Heywood does not explain why a person of ordinary skill in the art would be motivated to: (1) first start with the Adams gaming device, (2) then modify the Adams gaming device with Groetchen, (3) then modify the Groetchen modified gaming device with Heywood, (4) then add the Heywood modified gaming device to a network system with a remote server, (5) then have the server provide instructions to control the opening of the moveable member - but still have the processor of the gaming device randomly determine the symbols displayed by the secondary display behind the moveable member. Accordingly, Applicants respectfully submit that such rejection be withdrawn, that Claims 52 and 53 are patentably distinguished over the prior art cited and that such claims are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,
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Dated: February 13, 2007